No. 22,088

IN THE

United States Court of Appeals

For the Ninth Circuit

INDIANA GENERAL CORPORATION,
a Corporation,
Plaintiff-Appellant,

vs.

LOCKHEED AIRCRAFT CORPORATION,
a Corporation,
Defendant-Appellee.

BRIEF FOR DEFENDANT-APPELLEE

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STATEMENT OF THE CASE

Appellant's statement of the case is oversimplified and highly misleading. The real question in the case is this:

Where a first patent application discloses and claims a first *range of ingredient proportions* within which a known chemical compound possesses a first useful property, and a second patent application discloses and claims a different but slightly overlapping *range of ingredient proportions* within which the same chemical compound possesses a second and different

useful property, does the publication and public use for purposes involving the second property, of a material lying in the overlapping portion of both ranges, subsequent to the first application but more than a year before the second application, invalidate a patent derived from the second application?

The essential facts are as follows:

1. It was known as early as 1936 that ceramic bodies of magnesium-manganese ferrite could be made by shaping and firing mixtures of magnesium oxide, manganese oxide, and ferric oxide, and that these bodies had magnetic properties. (Snoek article, R. 683-704; Finding 28, R. 788).

2. On December 28, 1948, plaintiff's assignor filed patent application Serial No. 67,752. That application disclosed that magnesium-manganese ferrites whose ingredient proportions lie within a first specified range exhibit the unexpected advantage of having dielectric and insulating properties. (R. 886-924; Findings 15-18, R. 785-787). One of three examples (Example 3, R. 892) given in S.N. 67,752 of materials having ingredient proportions lying within the specified range was a material known as Ferramic A-34 (Finding 26, R. 788). There is no mention anywhere in S.N. 67,752 of anything concerning a hysteresis loop (a parameter relating to the magnetic properties of magnetic materials). (Finding 16, R. 786).

3. On May 10, 1949, Ferramic A-34 was placed on sale by plaintiff's predecessor. It was then used for electrical inductance uses in which its low-loss dielectric and insul-

lating properties were useful. (R. 277; Finding 20, R. 787; ll. 13-18, p. 2 of Snyder affidavit, R. 447).

4. In December 1949, plaintiff's predecessor caused to be published in the magazine "Electrical Manufacturing" an article (R. 271-276) discussing various ferrites and showing a photograph of the hysteresis loop of Ferramic A-34. The photograph showed the loop to be square. (R. 275; Finding 21, R. 787).

5. Square hysteresis loops are a highly useful property of some magnetic materials. Memory core materials for computers must have a square hysteresis loop in order to function as magnetic switches. (R. 6, col. 2, ll. 30-34 and 39-41). (Finding 12, R. 784).

6. Sometime in the summer of 1950, one W. N. Papian acquired some Ferramic A-34 from plaintiff's predecessor (R. 186, first paragraph) and used it in a research project on memory core materials for computers. He published his research and findings in his master's thesis, which the Court below found to have become a publication in the legal sense on or about October 19, 1950. (R. 311-394; Finding 24, R. 788, supported R. 309-311).

7. On October 30, 1951, plaintiff's assignor filed patent application Serial No. 253,799 (R. 234-245), from which the patent in suit was eventually derived. This application disclosed that magnesium-manganese ferrites whose ingredient proportions lie within a second specified range, *different* from the range specified in S.N. 67,752, exhibit the unexpected advantage of having square hysteresis loops. (Findings 9, 10, 13, R. 784). There is no mention of dielectric properties in the specification of the

patent in suit, only of the high resistivity said in S.N. 67,752 to be a known property of ferrites in general.[1]

8. The range of S.N. 67,752 overlaps the range of claims 1 and 3 of the patent in suit to a minor extent. The ingredient proportions of Ferramic A-34 are in the overlapping area. (Finding 31, R. 789). Ferramic A-34 is one of the examples given in S.N. 253,779 but is not specifically listed as an example in the patent in suit. *All other* examples given in S.N. 67,752 and *all* the examples listed in the patent in suit are *outside* the overlapping area (see triaxial diagram in Finding 15, R. 785).

9. The range defined by claims 2 and 4 of the patent in suit does not include Ferramic A-34. However, the patent in suit fails to disclose *in what way* the area of claims 2 and 4 differs from the area of claims 1 and 3

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[1]S.N. 67,752 states:

"Ferromagnetic ceramic bodies having the general formula $M''O.Fe'''_2O_3$ where M signifies a bivalent metal, *are known to have magnetic properties and to have a certain amount of resistance to the flow of an electric current.* Such bodies may be considered as semi-conductors since the specific resistance of such materials (when formed into core bodies for inductances, for example) is in the range of 10^2 to 10^6 ohms per centimeter cube. This resistance is an improvement over the metallic iron powder core or other ferromagnetic core materials but for many purposes, for example, where the magnetic part actually contacts conducting parts of the circuit, or where the magnetic part carries a conducting part or a conducting layer which forms part of the circuit, it would be desirable to have magnetic bodies which are insulators (rather than semi-conductors) or which have properties approaching or equalling those of a dielectric material." (ll. 4-18, R. 888; emphasis supplied)

"Ferromagnetic materials of the general formula stated above *as now made* usually have a mol proportion close to x:y=1:1; such substances have a resistance which does not exceed 10^6 ohm. cm even when the very resistant MgO is the bivalent metal oxide present." (ll. 20-24, R. 889; emphasis supplied)

except to state that it is "preferred". (R. 7, col. 3, ll. 46-47). (Finding 29, R. 789; Conclusion 10, R. 791). The reason for the preference is not given. On the basis of that fact, corroborated also by the deposition testimony of plaintiff's vice-president as quoted at R. 292-293 (set out in fn. 19, p. 33 hereof), the Court below concluded that claims 2 and 4 differed only in degree from claims 1 and 3.

Appellee submits that the Court below correctly found that:

(1) the invention disclosed and claimed in the patent in suit is the *range* of ingredient proportions in which magnesium-manganese ferrites exhibit the unexpected property of square-loopness;

(2) that invention was not disclosed or claimed in S.N. 67,752;

(3) a publication and public use for the purposes of that invention, of a material readable on some claims of the patent in suit more than one year prior to the filing of application S.N. 253,779 invalidated those claims;

(4) the remaining claims in suit, differing only in degree from the invalidated claims, are also invalidated by the same publication and public use.

RESPONSE TO SPECIFIC ASSIGNMENTS OF ERROR

1. Finding 20 finds a sale of Ferramic A-34 in 1949 (R. 277) for uses not involving its square-loop characteristic (R. 447); Conclusion 5 holds claims 1 and 3 invalid on grounds of publication and public use of the

square-loop invention recited in those claims. Hence, Conclusion 5 is not meant to be based directly on Finding 20. (See also our response to Error Assignment 7).

2. This goes to the heart of the case. The crux of the matter is that the patent's claims 1 and 3 are not directed to the material Ferramic A-34 as such, but to a range of compositions which happens to *include* Ferramic A-34—a vital distinction explained at length in the Argument.

3. The Court correctly found that the publication in 1949 of the square-loop property of one composition (Ferramic A-34) included within the range of compositions claimed in claims 1 and 3 of the patent in suit as square-loop compositions invalidates those claims, even though Ferramic A-34 had previously been disclosed to be a member of *another* range of compositions distinguished by a *different* kind of useful property.

4. Having failed to traverse the M.I.T. librarian's affidavit when it had a chance to do so, plaintiff is stuck with all reasonable inferences to be drawn from it. Certainly, the Court was justified in concluding from that affidavit that the Papian thesis became a "publication" before October 30, 1950.[2] Beyond that, we have the same comments as in respect to Error Assignment 3 above.

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[2]This date can be (and was, R. 309-311) established by evidence of regular library procedures: *Ex parte De Grunigen*, 132 USPQ 152 (P.O.Bd. App. 1958); 1961 C.D. 75 (Commissioner of Patents, 1961). Besides, it is the date of *receipt* at the library (here Oct. 9, 1950) that counts. In *Gulliksen v. Scott*, 75 USPQ 252, 257 (P.O.Bd. App. 1937), the Board said:

> "Since both affidavits referred to above clearly show that the thesis was received September 25, 1929, it is held that the dates when the same was bound or indexed is of no importance for the thesis became available to the public as soon as received in the library."

5. This again is the heart of the case. We refer the Court to the Argument for a discussion of why the Court below correctly found that the subject matter of the claims in suit was not disclosed in the patent application S.N. 67,752, and hence is not entitled to that application's filing date of December 28, 1948.

6. Same comments as in regard to Error Assignment 5 above.

7. Ferramic A-34 being a staple article of commerce as early as May, 1949 (R. 277, Finding 20, R. 787), no statement of ingredient proportions in the publications was necessary. Even though there is no evidence that any outsider ever *did* analyze Ferramic A-34, there is no dispute that anybody *could* have done so if he were interested.

8. This Error Assignment ignores the fact that the patent in suit does not *claim* Ferramic A-34; instead, it claims a range of materials distinguished by the square-loop property. S.N. 67,752, on the contrary, discloses another range of materials distinguished by *another* property. Ferramic A-34 merely happens to be included in both ranges.

9. Although Ferramic A-34 is *covered* by the claims of both S.N. 67,752 and the patent in suit, the claims of *neither* are *directed* to Ferramic A-34, and that makes all the difference in the world.

10. We refer to the Argument for the detailed showing of why the Court's finding in this respect was correct. "The manganese-magnesium ferrite material there-

in[3] disclosed'' (i.e., the range K-L-M-N of Fig. 3) in fact *did not have* square-loop properties except in a minority of instances.

11. Findings 13, 14, and 17 (R. 784-786) are supported by the 1936 Snoek article (R. 683 et seq., particularly R. 702-703), which constitutes indisputable evidence of what was old.

12. We refer to the Argument for a full discussion of why the Court's holding was correct in this respect on the basis that claims 2 and 4 differ only in degree from claims 1 and 3.

13. The Court was bound by the words of the patent in suit. No extraneous evidence can supply what is not in the patent.[4]

14. Again we refer to the Argument for a discussion of this point, which goes to the heart of the case.

15. The Court correctly found that the ranges, and the properties associated with each, were *different* in S.N. 67,752 than in the other applications.

16. The Court below simply made no such conclusion.

17. Inasmuch as the group or range of compositions disclosed in the 1948 application was materially different from the group or range of the patent in suit, the Court committed no error in this respect.

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[3]In S.N. 67,752.

[4]*Minnesota Mining and Mfg. Co. v. Carborundum Co.*, 155 F. 2d 746, 749 (C.A. 3, 1946):

> ". . . the words of a patent or patent application, like the words of specific claims therein, always raise a question of law for the court and may not be determined by the opinion of experts."

18. As pointed out in the Argument, there are no disputed issues of fact capable of affecting the outcome.

19. The quoted statement of the Court is not made the basis of any finding, and the context clearly indicates that the technical inaccuracy in this statement is no more than a slip of the pen. Moreover, the Court on appellant's motion for reconsideration corrected itself and still came up with the same result (R. 769).

20. This again goes to the heart of the case, and we refer to the Argument for a full discussion of this point.

SUMMARY OF THE ARGUMENT

The invention disclosed and claimed in the patent in suit is not, as appellant urges, a single chemical composition as such, but rather the range, as a coherent entity, of ingredient proportions of a known chemical compound within which the compound exhibits a particular useful property.

Thus, the property is inseparably interwoven in the *range* of compositions claimed in the patent in suit, and the claims would be senseless in the absence of a reference to the property which gave them birth.

The untimely publication and public use of a material lying in the claimed range, *for the property underlying that range,* is fatal to any claim of the patent in suit which includes that material.

The fact that this same material was previously disclosed in a prior application to lie within a *different,* though slightly overlapping, range associated with a *dif-*

ferent useful property cannot save the anticipated claims, because the prior application was directed to a different invention altogether.

The patent claims which are not directly anticipated differ only in degree from the anticipated ones, and must therefore fall with them as a matter of law.

ARGUMENT

1. BACKGROUND

It is axiomatic that the basic purpose of the patent laws is to give an inventor a limited monopoly over his invention in exchange for teaching the public, by way of the patent, something new and useful.[5] The key to this whole lawsuit lies in a straight-forward, common-sense application of that principle to the undisputed facts of this case.

The facts are really quite simple. In 1948, appellant discovered that a certain known ceramic compound (called magnesium-manganese ferrite) exhibits peculiar dielectric and insulating properties when its ingredients are mixed within a certain range of proportions. Appellant thereupon applied for a patent on all embodiments of the old

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[5] *International Nickel Co. v. Ford Motor Co.*, 166 F. Supp. 551, 561-562 (S.D.N.Y., 1958) quoting from *Pittsburgh Iron & Steel Co. v. Seaman Sleeth Co.*, 248 F. 705 (C.A. 3, 1917):

> "The Patent Law seeks to reward those who teach the public how to perform, process or construct things which the public theretofore was unable to do because of insufficient information."

compound whose ingredient proportions lie within that range.

In 1949, appellant placed one such dielectric embodiment (called Ferramic A-34) of the compound on the market. Appellant now discovered that Ferramic A-34 also has another peculiar property: it has a square hysteresis loop. Appellant published that fact in 1949, and a university researcher used appellant's material in early 1950 for computer research which required the square hysteresis loop property.

In late 1951, appellant filed a patent application stating that the same known ceramic compound (i.e. magnesium-manganese ferrite) has square-loop properties when its ingredients are mixed within another, different range of proportions. The two ranges do slightly overlap; and Ferramic A-34 is located in the overlap. Appellant succeeded in obtaining a patent which claims, as a group, all embodiments of the old compound whose ingredient proportions lie within the square-loop range.

The crucial question is: Does the 1948 application disclosing and claiming the *dielectric* range of embodiments support the patent claims claiming the *square-loop* range of embodiments just because a few embodiments happen to have both dielectric *and* square-loop properties? If it does, a reversal is indicated. If it does not, the 1949-50 publications and use constitute a statutory bar, the Court below was right, and its judgment should be affirmed.

Applying the basic policy of the patent laws to this situation, the result is clear: In the 1948 application the public was *not* taught how to mix, or how not to mix,

the ingredients in order to get a square-loop material.[6] Since that teaching is the quintessence of the claims of the patent, the patent claims are obviously *not* supported by the 1948 application.

Seen in this light, it is evident that appellant's entire case rests on a simple, concise, and fatal fallacy: The patent in suit is *neither* a patent for the specific composition known as Ferramic A-34, *nor* a patent for the old chemical compound known as magnesium-manganese ferrite. It is a patent on a coherent *group* of compositions distinguished by their common property of square-loopness. Once this basic truth is understood, appellant's case falls like a house of cards, as we will now explain in detail.

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[6]It might be argued that the publication and use of Ferramic A-34's square loop did not teach the public the *extent* of the range within which square loopness occurs. But that is of no consequence: the law is clear that the invention resides in the discovery that such a range *exists,* and the routine process of determining the precise limits of the range is not of itself inventive, as this Court has held in *Locklin v. Switzer Bros., Inc.,* 299 F.2d 160 (1961), quoting *Application of Aller,* 220 F.2d 454, 456 (C.C.P.A. 1955):

> "More particularly, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation."

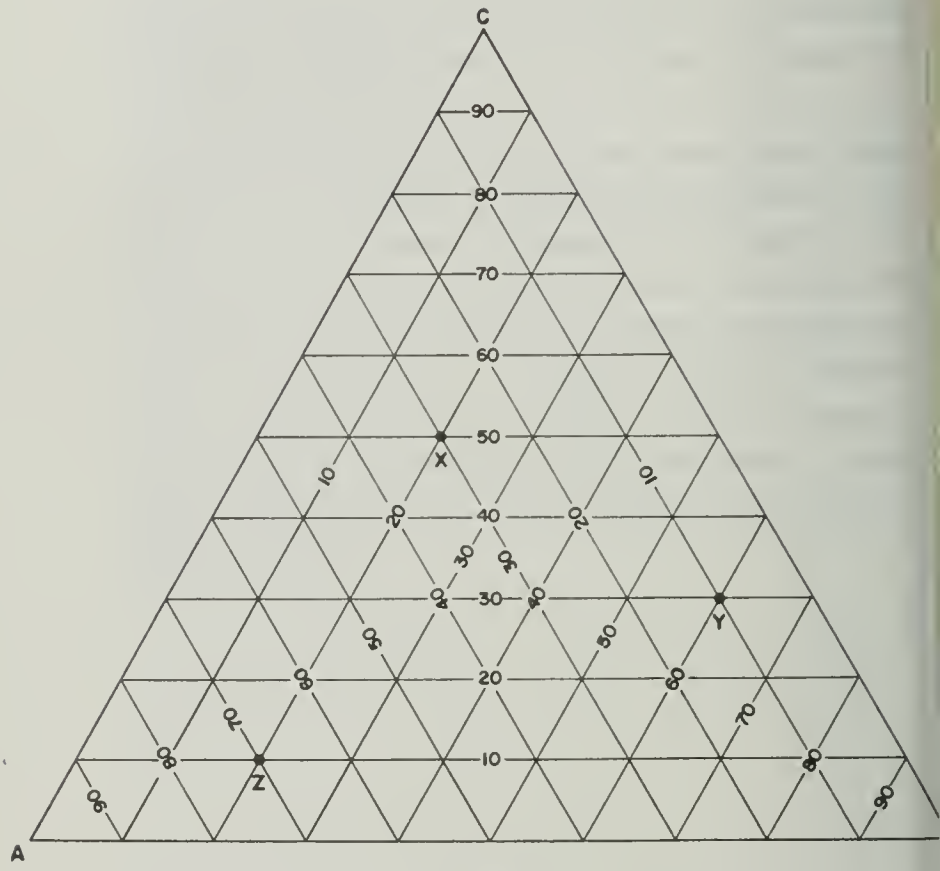
C
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Fig. 1

2. HOW TO READ A TRIAXIAL DIAGRAM

Before getting into a detailed discussion of the patent in suit, it is necessary to understand what a triaxial diagram is. If the reader already knows, this section may be skipped.

A triaxial diagram is a graphic representation of all possible mixture proportions of a chemical compound which contains three specified ingredients. Fig. 1 inserted opposite shows a typical triaxial diagram.

In Fig. 1, the apex A of the triangle represents a composition which contains 100% of ingredient A and 0% of ingredients B and C. The line BC represents all possible compositions which contain 0% of ingredient A. For example, end B of that line represents a composition which is 100% B; the midpoint of line BC represents a composition which is 50% B and 50% C; and the end C of the line represents a composition which is 100% C.

Any point inside the triangle ABC represents a composition which contains some A, some B, and some C. The position of the point in the triangle determines how much A, B, and C, respectively, is in the composition represented by that point. For example, point X represents a composition containing 30% A (note that it is located on the line marked "30" parallel to the line BC), 20% B (the line marked "20" parallel to AC), and 50% C (the line marked "50" parallel to AB).

Likewise, point Y in Fig. 1 represents a composition containing 10% A, 60% B and 30% C; and point Z represents a composition containing 70% A, 20% B, and 10% C.

3. THE PATENT IN SUIT

Appellee notes with interest that nowhere in its brief did appellant dare quote the patent in suit (R. 5-9) or any of the antecedent applications involved to show the Court what the invention is all about. Consequently, we shall first of all correct that omission.

Fig. 4 of the drawing of the patent in suit is reproduced opposite as Fig. 2 of this brief.

It will be seen that this figure is a triaxial diagram representing all possible compositions made up of the ingredients magnesium oxide (MgO), manganese oxide (MnO) and iron oxide (Fe_2O_3).

Drawn onto this triaxial diagram is a line A--B--C--D--E--A encompassing a specific area of the diagram. There is also a line G--H--I, but that line is unimportant for the moment and will be discussed later herein.

The patent in suit (whose title is "SQUARE LOOP FERRITES") says in essence the following (col. 1, ll. 16-26; col. 3, ll. 22-25):

> "This invention relates to the production of ferromagnetic ceramic bodies which have hysteresis loops of substantially square or rectangular shape and to the bodies so produced.
>
> Among the objects of the invention is to provide a approach very closely to a square or rectangular shape. (sic)
>
> Among other objects of the invention is to provide a ceramic type of ferromagnetic material which has a substantially square or rectangular hysteresis loop

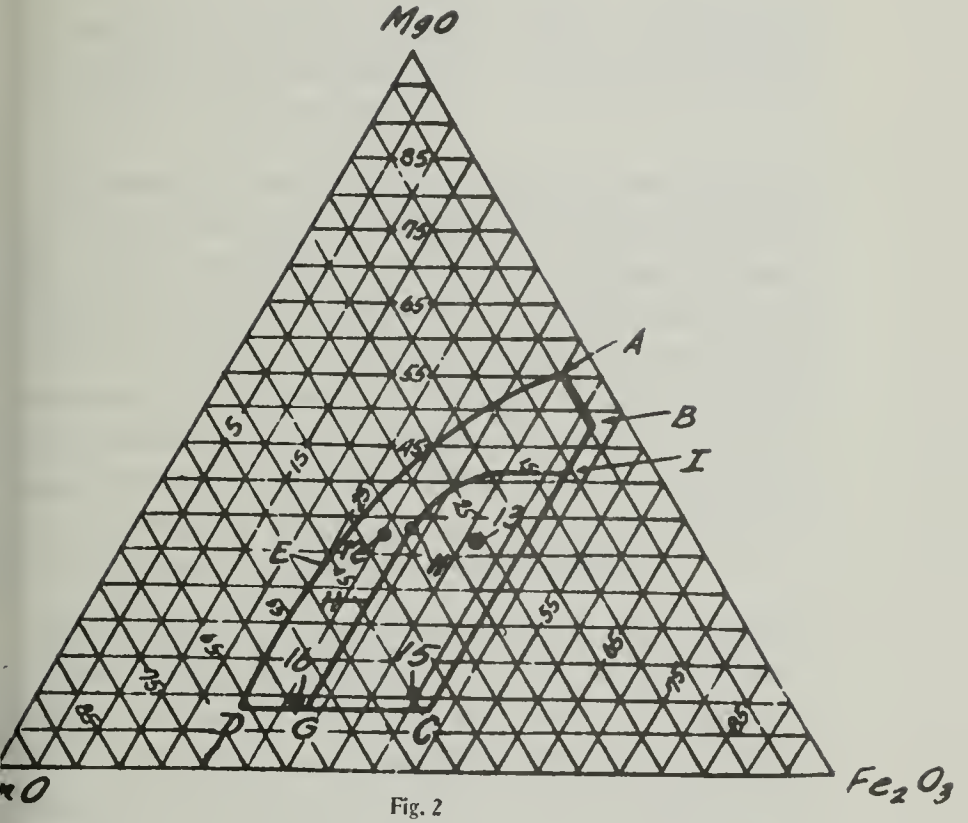

Fig. 2

and a very high speed of action, for example of (sic) the order of one micro-second or less.

* * *

The proportions of the components in the MgO--MnO--Fe_2O_3 system which produce square loop ferrites are those within the area A--B--C--D--E--A of Fig. 4 of the drawing."

As a matter of explanation, all magnetic materials have a so-called hysteresis loop, which is a graphic representation of how reluctant the material is to change its magnetization back and forth when it is subjected to the action of an alternating electric magnetizing current. As appellant correctly states in its brief (p. 4), this graphic representation can, by well-known methods, be made to appear as a luminous trace on the screen of an oscilloscope to which a sample of the material is connected. This trace can be observed and photographed.

Most magnetic materials have a hysteresis loop that looks somewhat like a stylized "S" with a more or less bulging mid-section (see, e.g. the traces of Ferramic B-90, C-156, D-146, and E-141 on p. 87 of the *Electrical Manufacturing* article (R. 272)). Some magnetic materials (e.g. certain old metal alloys (R. 573) and some of the ferrites involved here) have a hysteresis loop in which the bulging mid-section has more or less square corners (see the trace of Ferramic A-34 in the *Electrical Manufacturing* article (R. 272), shown in enlarged form at R. 400). These so-called square loop materials are useful, i.a., in computers because, to quote the patent in suit,

> "In use, the sharp cornered materials give an effect similar to the sudden snapping in a mechanical switch and since these ferrites are used to produce effects analogous to switching this property is every important." (col. 2, ll. 30-34).

Coming back to our analysis of the patent in suit, the patent goes on to define "square loop", discusses the ingredients of the triaxial diagram and possible substitutes, and gives seven examples of how core bodies of various ingredient proportions can be made from specified raw materials. The patent concludes with six claims, a typical one of which defines the invention of the patent in suit as follows:

> 1. A fired ferromagnetic ferrite body *having a square hysteresis loop* consisting essentially of a manganese-magnesium ferrite and consisting essentially of 8-55 mol percent of magnesia, 4-67 mol percent of manganese oxide and from 25 to about 47.5 mol percent of ferric oxide, *the proportions of said components being within the (area) A--B--C--D--E--A of Fig. 4 of the drawing.* (Emphasis and parenthetical matter supplied)

This recitation of the square loop property and of the ingredient proportion area in which it occurs forms part of, and constitutes the essence of, *every* claim of the patent in suit.

4. IF APPELLANT'S POSITION IS CORRECT, THE PATENT IN SUIT IS INVALID ON ITS FACE AS DIRECTED TO UNPATENTABLE SUBJECT MATTER

If appellant's assertion throughout its brief that the square-loop property is merely a *new use* of Ferramic A-34 is to be believed, then the patent in suit is actually an invalid attempt to patent, by way of article claims, a new use of an article of manufacture (a fired magnesium-manganese ferrite body) which was known as early as 1936. Appellant devotes the major part of its brief to the proposition that a new use of an old thing simply cannot be patented unless it is claimed as a process (which is not the case here). There is little we can say to improve upon appellant's argument in that respect.

Take claim 1, quoted above, and delete from it all language *not* relating directly to the square hysteresis loop property. What is left is this:

> "A fired ferromagnetic ferrite body . . . consisting essentially of a manganese-magnesium ferrite . . .".

Was that new even in 1948?[7] Of course not. The Snoek article (R. 683 et seq.) discloses, as early as 1936, the existence of fired ferromagnetic ferrite bodies consisting essentially of a manganese-magnesium ferrite. At pp. 481-482 of that article (R. 702-703), Snoek discusses "mixed" ferrites, i.e. ferrites made up of iron oxide and two other oxides. In Table VI, Snoek shows that the Curie point for a manganese-magnesium ferrite is 330° centigrade.

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[7]The earliest application involved in this lawsuit has a filing date of December 28, 1948.

"Curie point" is defined in Van Nostrand's Scientific Encyclopedia, Third Edition (1958), p. 463, as follows:

> "*Ferromagnetic materials* lose their permanent or spontaneous magnetization above a critical temperature (different for different substances). This critical temperature is called the Curie point." (Emphasis supplied).

At p. 466 of the same article (R. 687), Snoek explains on what bodies his measurements were made:

> "The specimens had the form of long and thin rectangular bars (60 x 2 x 3 mm)."

That these bars were fired appears, i.a., from Snoek's statement at pp. 463-464 of the article (R. 684-685) that the ferrites

> ". . . can be made by thoroughly mixing the finely divided oxide components in powder form, pressing it into a bar and heating the latter for a long time in air or oxygen at temperatures varying from 1000°-1300°C according to the nature of the added oxide."

This process is "firing" within the broad meaning of the patent in suit since, in at least one example of the patent, a "finely divided and thoroughly mixed . . . powder (of the oxide components) . . . shaped by pressing" (ll. 21-25, col. 4) is "*fired* in air at about 2350°F (i.e. about 1286°C) . . ."(l. 68, col. 4). (Emphasis and parenthetical matter supplied).

Appellant does not contest the fact that the Snoek article is a prior art publication within the meaning of 35 USC 102 (a). Therefore, taking appellant's view:

> *Fired ferromagnetic ferrite bodies consisting essentially of a manganese-magnesium ferrite being old, the novelty, if any, claimed in the patent in suit consists of nothing more than an unpatentable newly discovered property or use of some of those bodies, and a statement of which of those bodies have that property or use.*

Thus, if appellant's view that the square-loopness is merely a new use of an old composition, that composition has to be magnesium-manganese ferrite as such, and appellant is defeated by his own principal authority, *Application of Kirchner,* 305 F. 2d 897, 903 (C.C.P.A. 1962) as quoted by appellant at p. 26 of its brief:

> "Coan's view is untenable and if adopted could lead to extraordinary results. Thus, the same compound could be repatented as often as a new use could be found, merely on the ground that the invention was different and even an infringer of a patented compound could escape by the same route."

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5. THE NATURE OF THE INVENTION

If the Court is not disposed to espouse appellant's view and consequently to hold the patent in suit invalid on its face as directed to a new use of an old compound, on the basis of the reasoning outlined above, it next becomes necessary to consider what the invention has to be.

Appellant urges that the invention of the patent in suit is a composition of matter. We have referred to it as an article of manufacture, because it is claimed as a "body" rather than a "ferrite" as such. Either way, the proportion of ingredients of the ferrite that makes

up the body is the gist of the claims and of the litigation.

If, as appellant says, the invention is a composition of matter, *what* composition of matter can it be? Can it be magnesium-manganese ferrite as such? No, because magnesium-manganese ferrite was already known to Snoek in 1936. Can it be the *specific* composition of Ferramic A-34 alone? No, because Ferramic A-34 was *merely one example* of a *group* of compositions having a *common utility* (a square hysteresis loop). This *group* of compositions was always treated and defined *as a group,* e.g. ". . . a manganese-magnesium ferrite . . ., the proportions of said components being within the (area) A--B--C--D--E--A of Fig. 4 of the drawing."

That a group or *range* of ingredient proportions of a known composition, which group has a common peculiar utility, is patentable *per se* appears from plaintiff's own case of *Allegheny Ludlum Steel Corp. v. Westinghouse Electric Corp.,* 150 USPQ 95 (D.C.D.C. 1966), (Plaintiff's brief, p. 31) in which Judge Holtzoff said "The specific invention consists in the use of a specified *range of proportions* of boron in order to produce the desired quality . . ." (Emphasis supplied).

If the invention had been Ferramic A-34 as such, the claim would have had to read "A fired ferromagnetic ferrite body consisting essentially of a manganese-magnesium ferrite consisting essentially of 52 mol percent of magnesia, 7 mol percent of manganese oxide, 41 mol percent of ferric oxide, and 1 mol percent of zinc oxide", because that is the composition of Ferramic A-34 (R. 139). Appellant, we believe, will agree that none of

appellee's products (identified at R. 227) come anywhere near that composition of Ferramic A-34. Hence, *if the invention had been Ferramic A-34,* appellee would not have infringed it and this lawsuit would never have existed.

To recapitulate:

1) The invention of the patent in suit cannot be manganese-magnesium ferrite as such;

2) It cannot be Ferramic A-34 as such;

3) It therefore can only be the group, *as a coherent group,* of ferrites within the area A--B--C--D--E--A. Perhaps this point, if not already clear, can best be explained by a simple analogy. It is rather obvious, we believe, that if widgets are known, you cannot get a patent on blue widgets unless you can show that blue widgets can do something unobvious that no other widgets can do.

This case presents the same situation: manganese-magnesium ferrites being known, you cannot get a patent on manganese-magnesium ferrites within the area A--B--C--D--E--A unless you can show that the ferrites within that area have the unobvious useful property of a square hysteresis loop that the ferrites *outside* that area do *not* have.

In other words, in the absence of the square hysteresis loop as part and parcel of the invention, the limitation of the area A--B--C--D--E--A doesn't make any sense. If you know, as Snoek did in 1936, that you can make fired ferromagnetic ferrite bodies out of manganese oxide, magnesium oxide, and ferric oxide, you would have no

reason to mix the ingredients in one proportion rather than another *unless* you knew that certain specific proportions would give the body the particular properties needed for the *use* to which you propose to put the body.

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6. APPLICATION SERIAL NO. 67,752

At this point it becomes necessary to consider the parentage of the patent in suit. Appellant claims (see patent in suit, col. 1, ll. 43-48) that the invention of the patent in suit is derived, through various continuation-in-part applications,[8] from application Serial No. 253,779[9] filed October 30, 1951. So far we agree. But then appellant claims (and here we disagree) that the relevant subject-matter of S.N. 253,779 was disclosed earlier in application Serial No. 67,752[10] filed December 28, 1948, of which S.N. 253,779 purports to be a continuation-in-part.

Consequently, let us compare the disclosure of the patent with the disclosure of S.N. 67,752. S.N. 67,752 starts out:

> "This invention relates to a composition of matter which has magnetic properties and at the same time has high insulating properties."

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[8]A continuation-in-part application is one which discloses all or part of the subject matter of a previously filed application plus something new. As to the *old matter*, the effective filing date is the date of the previous application; as to the *new matter*, it is the date of the continuation-in-part application.

[9]File wrapper at R. 234-270; text of the application at R. 236-243, drawing at R. 245.

[10]File wrapper at R. 886-924; text of the application at R. 888-894. No drawing.

The statement of objects is more explicit:

> "An object of this invention therefore is to provide a ferromagnetic body *which has insulating properties.*
>
> Another object of the invention is to provide a ferromagnetic body *which has insulating and dielectric properties.*
>
> Another object of the invention is to provide a core body of magnetic ferrite materials *which has insulating and dielectric properties.*" (Emphasis supplied).

There follow other objects of similar import, a discussion of resistance properties of ferrites in general, examples including manufacturing method data, and claims of which the following is typical for the purposes of this case:

> 4. A ceramic body having magnetic properties *and having a specific resistance in the order of* 10^8 *to* 10^9 *or more and a power factor of less than 2%* consisting essentially of a magnesium ferrite of the general formula x MgO.y Fe_2O_3 *in which x:y is between 1.6:1 and 2:1,* said ferrite composition containing MnO as a fluxing agent in the proportion of less than 10% but in sufficient quantity to decrease the firing range of said composition to a temperature of less than 1400°C. (Emphasis supplied)

MnO, of course, is manganese oxide; MgO is magnesium oxide, and Fe_2O_3 is ferric oxide.

Note that *nowhere* in S.N. 67,752 is there *any* mention of the square hysteresis loop property. It is clear from the specification of S.N. 67,752 (e.g. at R. 890, ll. 5-6) that the "magnetic properties" referred to in the quoted pas-

sages are simply the ferromagnetism inherent in manganese-magnesium ferrites, as already recognized by Snoek.

S.N. 67,752 has no drawing, but it is possible by simple calculations on the basis of that application's specification, which discloses broadly a magnesium oxide-ferric oxide ratio of between 1.2:1 and 3:1 (R. 889, ll. 17-18) and a magnesium oxide content of not more than 10% (R. 890, ll. 22 and 27-28), to plot on a triaxial diagram an area K--L--M--N (R. 679) representing all possible compositions within that disclosure. The relationship between that area K--L--M--N and the area A--B--C--D--E--A of the patent in suit is shown by the triaxial diagram of Fig. 3 inserted opposite.

The following facts appear from Fig. 3 and from the listing of appellee's products (R. 227):

1) A minor portion of the area K--L--M--N overlaps a minor portion of the area A--B--C--D--E--A;

2) Ferramic A-34 lies in the overlapping portion;

3) All other examples of S.N. 67,752 and all examples of the patent in suit lie outside the overlapping portion; and

4) Appellee's accused products also lie outside the overlapping portion.

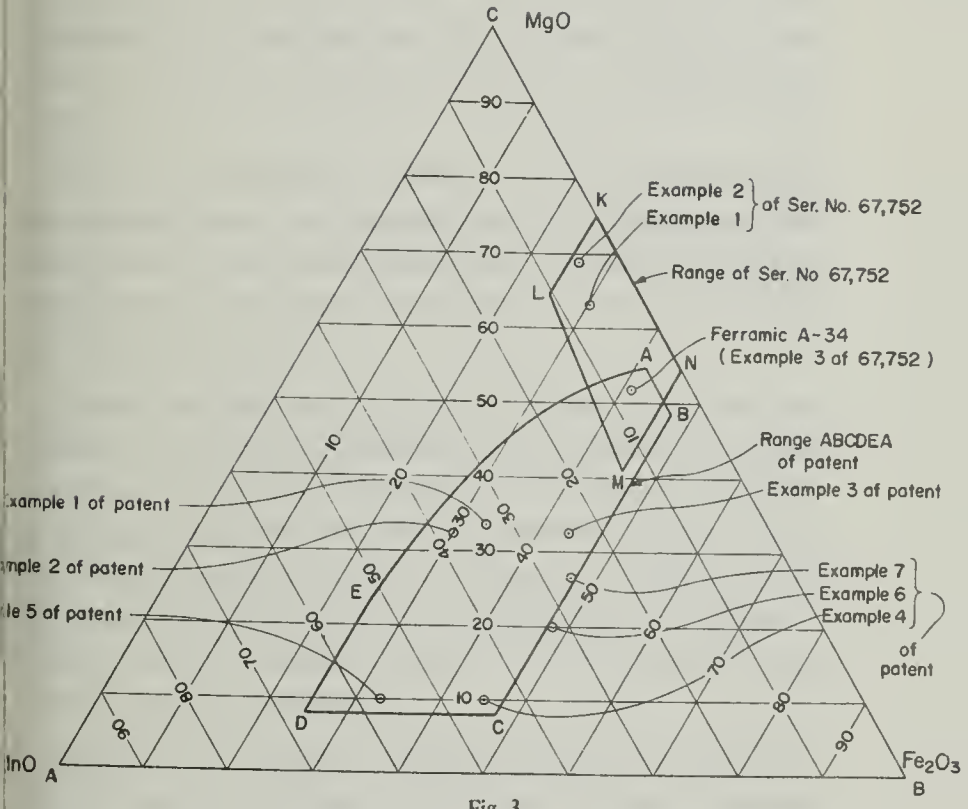
C
MgO
90
80
70
60
50
40
30
20
10
K
L
A
N
B
M
E
D
C
Example 2
Example 1
of Ser. No. 67,752
Range of Ser. No 67,752
Ferramic A-34
(Example 3 of 67,752)
Range ABCDEA
of patent
Example 3 of patent
Example 7
Example 6
Example 4
of
patent
xample 1 of patent
mple 2 of patent
le 5 of patent
nO
A
Fe2O3
B

Fig. 3

7. EFFECTIVE FILING DATE OF THE INVENTION CLAIMED IN THE PATENT IN SUIT

Now we can come back to our widget analogy. Suppose you have discovered that red and purple widgets cure headaches. You conclude that all widgets that have some red in them cure headaches, and this you disclose and claim.

Later on, you discover that blue and purple widgets make grass grow. You conclude that all widgets that have some blue in them make grass grow, and this you disclose and claim in a separate application on which a patent eventually issues.

Would the disclosure of headache-curing red-containing widgets in the first application be a disclosure of grass-growing blue-containing widgets just because purple widgets contain both red *and* blue and therefore are inherently (as later discovered) both a headache cure *and* a grass growing agent? Of course not. "Red-containing widgets" are just simply different things with different utility than "blue-containing widgets".

Likewise, the *group* of compositions in the area K--L--M--N, which is distinguished by the common dielectric and insulating property (i.e. having a specific electrical resistance between 10^8 and 10^{10} ohms-cm.), is a coherent entity entirely separate and distinct from the *group* of compositions in the area A--B--C--D--E--A, whose common denominator is a square hysteresis loop. Therefore:

> *If the invention of the patent in suit is a "composition of matter", the inventive "composition" is the group of compositions, as a coherent entity, defined by the area A--B--C--D--E--A of the patent. That*

group of compositions is not disclosed by a disclosure of the group of compositions, as another and different coherent entity, defined by the area K--L--M--N of S.N. 67,752. Consequently, the effective filing date of the invention claimed in the patent in suit is October 30, 1951.

In *Larsen Products Corp. v. Perfect Paint Products, Inc.*, 191 F. Supp. 303, 315-316 (D. Md., 1961), the same question as here arose when the plaintiff patentee sought to avoid a public use bar by going back to the parent application of her continuation-in-part patent. The court said:

> "B. These claims are also barred by the public use from May 1, 1952, to April 14, 1953, of 'Plaster-Weld' made in accordance with the teaching of Claims 2 and 3, and used in accordance with the process claimed in Claims 4 to 8. Plaintiffs vainly seek to avoid this result by asserting that the 1954 application is a continuation-in-part of the 1952 application, and that under sec. 120 the effective date of all the claims in the patent in suit is April 11, 1952.
>
> * * * * * *
>
> Section 120 provides that a patentee may have the benefit of an earlier filing date if, inter alia, the earlier application contains the disclosure required by the first paragraph of sec. 112, which provides: 'The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most clearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.' See also Rule 118 of the Rules of Practice of the U.S. Patent

Office, 37 C.F.R. 1.118, 35 U.S.C.A. App. 1. Thus the question is whether the process claimed in Claims 4 to 8 of the patent in suit is disclosed by the April 11, 1952 application in the manner required by sec. 112.

A common feature of Claims 4 to 8 is 'drying the film' (in one instance 'permitting the film to dry'). Plaintiffs' counsel has argued that this is an essential element of the process.

* * * * * *

If 'drying the film' is an essential part of the process, as plaintiffs now contend, that element was not disclosed by the 1952 application.

* * * * * *

For the purposes we are now considering, however, the important point is not that the 1952 application was inaccurate, but that in this respect the 1952 application is so different from the 1954 statement and claims that it did not disclose in 'full, clear, concise and exact terms' the invention claimed by Claims 4 to 8 of the patent in suit.

For each of these reasons, therefore, the effective filing date of the process claims of the patent in suit is April 14, 1954, and the claims are barred by the public use of the process more than one year prior to that date. . . . 'To sustain the claims in question upon the established and admitted facts would require a plain disregard of the public interest sought to be safeguarded by the patent statutes, and so frequently present but so seldom adequately represented in patent litigation'."

8. EFFECT OF PAPIAN'S USE OF FERRAMIC A-34 IN 1950

W. N. Papian in 1950 was a student at M.I.T. studying for a Master of Science degree. His thesis (R. 311-394) shows, if nothing else, that sometime before August 31, 1950, he obtained bodies of Ferramic A-34 (R. 360 et. seq.) and used them as square-loop devices (R. 319). Whether that use was for computer research or for commercial purposes is academic; it was an uncontrolled use by a member of the general public and hence a public use within the meaning of 35 USC 102 (b).[11]

Hence, the evidence below clearly shows that at least one member of the group of compositions within the area A--B--C--D--E--A was in public use *for the purpose which gives meaning to the area A--B--C--D--E--A,* more than one year prior to the effective filing date of the patent in suit.

To again use the widget analogy, a purple (blue-containing) widget was publicly used to grow grass more than a year before the application for grass-growing blue-containing widgets.

Ferramic A-34 is encompassed by Claims 1 and 3 of the patent in suit. The law is clear that an untimely publication or public use of one member of a group of compositions claimed as an entity, which discloses or uses the

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[11] "A person shall be entitled to a patent unless— . . . the invention was . . . in public use or on sale in this country, more than one year prior to the date of the application for patent . . ."

Application of Blaisdell, 242 F.2d 779, 783 (C.C.P.A. 1957), quoting *Egbert v. Lippmann,* 104 U.S. 333 (1881):

> "* * * If an inventor, having made his device, gives or sells it to another, to be used by the donee or vendee, without limitation or restriction or injunction or secrecy, and it is so used, such use is public, even though the use and knowledge of use may be confined to one person."

property common to the group, bars any claim to the group as a whole.[12]

Therefore:

Claims 1 and 3 of the patent in suit are invalid as a matter of law under 35 USC 102 (b) in view of the

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[12]In *Application of Perkins*, 346 F.2d 981 (C.C.P.A. 1965), one of the claims whose rejection was being appealed was of the same form as the claims involved here:

"1. A novel composition of matter characterized by excellent malleability, ductility and low work hardening, and also having resistance to oxidation and corrosion consisting essentially of between 90 and 70 percent by weight of tantalum and between 10 and 30 percent by weight of titanium."

Discussing the rejection by the Patent Office Board of Appeals of this claim on two references, the court said:

"Both references describe the preparation of alloys having compositions falling within the claimed range."

* * *

"The board was somewhat more precise in phrasing the rejection, stating:

* * * the properties recited in the instant claims concerning malleability, ductility, low work hardening, and oxidation and corrosion resistance, are too broad and general to distinguish the alloys. *Appellants do not deny that the alloys of the references possess the same broadly recited properties.*"

* * *

"We are of the opinion that claims 1, 2 and 3 drawn to the alloy as a composition of matter were properly rejected under 35 U.S.C. §102. While appellants do not deny that the prior art discloses compositions falling within the claimed range, they rely upon other recitations in the claims. Appellants argue that by setting forth the ranges, between 10 and 30 percent by weight of titanium (claim 1) and between 4 and 15 percent by weight of titanium (claim 2), they distinguish over the art. *When the claim is directed to a composition and the prior art falls within the range, we do not feel that the arguments directed to the range can have any bearing upon a '102 rejection.'*" (Emphasis supplied)

Application of Tanczyn, 202 F.2d 785 (C.C.P.A. 1953), and *Rem-Cru Titanium Inc. v. Watson*, 147 F. Supp. 915 (D.C.D.C. 1957) held that similar range claims are not anticipated by a reference showing a composition within the range *when that reference fails to disclose* the *property* which distinguishes the range. It logically follows that range claims *are* anticipated by a reference showing a single composition within the range if the reference, as in the present case, *does* disclose the property on which the range is based.

public use by W. N. Papian of the subject-matter thereof more than one year before the effective filing date of the patent in suit.

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9. EFFECT OF THE PUBLICATIONS

Appellee contends, and the Court below agreed,[13] that the invention claimed in claims 1 and 3 of the patent in suit is shown in two publications each published more than a year prior to the effective filing date of the patent in suit.[14] The two publications are the 1949 *Electrical Manufacturing* article[15] co-authored by appellant's vice-president Snyder, and the Papian thesis.[16] The sufficiency of appellee's proof of the publication date of the latter is questioned, though not discussed, in appellant's Error Assignment No. 4, but in view of the discussion of that point in the footnote to our response to Error Assignment No. 4 (p. 6 of this brief), let us assume that it is fatally early.

Both publications undisputedly show that ferromagnetic core bodies made of a ferrite called Ferramic A-34 and made by General Ceramics and Steatite Corporation (appellant's predecessor) have a square hysteresis loop.[17]

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[13]Finding No. 21, R. 787; Findings Nos. 23, 24, R. 787-788.

[14]35 USC 102(b): "A person shall be entitled to a patent unless— . . . the invention was . . . described in a printed publication . . . more than one year prior to the date of the application for patent . . ."

[15]R. 271-276.

[16]R. 311-394.

[17]Finding 21, R. 787; see the picture of the loop of Ferramic A-34 on p. 87 of the *Electrical Manufacturing* article (R. 272, shown enlarged at R. 400); and see the Papian thesis at R. 319, R. 360, and R. 378.

Admittedly, neither publication discloses the ingredient proportions or even the ingredients (other than ferric oxide) of Ferramic A-34. Appellant contends that this is necessary to make the publications *publications of the invention;* we contend that it is not.

Back to the widget analogy: if purple widgets can be bought on the open market, and an article discloses that purple widgets make grass grow, what difference does it make to the grass-growing public what widgets are made of? The public has been taught fully and completely by that article all it needs to know: that if you want to grow grass, use purple widgets.

Likewise, both publications tell the public: If you want ferromagnetic ferrite bodies that have a square hysteresis loop, go to General Ceramics and buy Ferramic A-34. This is precisely what Papian did when he wanted a square-loop ferrite for his computer research.

Again, a publication fatal to one member of a coherent group is fatal to the entire group: *Application of Perkins, supra,* fn. 12 p. 29 and the discussion in that footnote.

Therefore:

> *Claims 1 and 3 of the patent in suit are invalid as a matter of law under 35 USC 102 (b) in view of the publication of the subject matter thereof in the* Electrical Manufacturing *article and in the Papian thesis, or either of them, more than one year before the effective filing date of the patent in suit.*

10. INVALIDITY OF CLAIMS 2 AND 4

Claims 2 and 4 of the patent in suit are just like Claims 1 and 3, except that instead of encompassing all compositions within the area A--B--C--D--E--A, they encompass only those within the smaller area C--G--H--I--C (Fig. 2 of this brief, which is Fig. 4 of the patent in suit).

Admittedly, Ferramic A-34 is *not* within the area C--G--H--I--C, and therefore its use and publication prior to the critical date is not *directly* fatal to claims 2 and 4. Appellee contends, however, that under the applicable rules of law, the invalidity of claims 1 and 3 carries with it, under the circumstances of this case, the invalidity of claims 2 and 4.

The determinative factor in this respect is the fact that area C--G--H--I--C differs only in degree from the area A--B--C--D--E--A. In establishing this fact, it is only necessary to look at the patent in suit, because its disclosure, in order to satisfy 35 USC 112,[18] has to be complete in itself.

The *only* statement made in the patent in suit about the area C--G--H--I--C is:

> "The preferred range of mol percentage of the components is within the area C--G--H--I--C." (col. 3, ll. 46-47).

Nowhere is there any mention of why that area is preferred, or what is different about it, or how much better it

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[18] "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

is. As a matter of fact, the loop squareness (B_r/B_s) of Example 5 which lies *outside* the area C--G--H--I--C is *better* than that of Example 4, which is *inside* that area. Admittedly, the squareness of Example 3, inside the area, is highest.

It is absolutely clear, however, from a comparison of the data given for each of the plotted Examples 1 through 5, that in none of the disclosed parameters are the "inside" examples (3, 4 and borderline 1) clearly different from the "outside" examples (2 and 5). What inconclusive differences there are from one example to the other are strictly matters of degree, and small degree at that.[19]

Coming back to the widgets, this is like saying that navy blue widgets are preferred over other blue-containing widgets; presumably because some of them grow grass a little faster, and some grow a little greener grass, than do other blue-containing widgets.

This Court has held only recently that where a broad claim is invalidated by a public use, a narrow claim that differs from the broad claim only in degree is also invalidated by the same public use, *even though* the fatal use is not directly readable on the narrow claim, in *Cataphote Corp. v. De Soto Chemical Coatings, Inc.*, 356 F. 2d 24

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[19]Appellant's viee-president corroborated this view in his deposition (p. 42 thereof as quoted at R. 292-293):

"Q. Do you know whether the loops of the materials that you sell today commercially are any squarer than A34, for example?

A. Oh, yes.

Q. Are they a completely different thing or are they just as a matter of degree squarer than they used to be?

A. As a matter of degree."

(1966). In that case, the District Court had held that a patent for a certain plastic highway marking composition made with styrene resin was invalid because of a public use more than one year before the application. The District Court had then held that a second patent, which had issued from a continuation-in-part of the first patent's application, and which claimed the same product made with alkyd resin instead of styrene resin, was also invalid by virtue of the public use of the analogous styrene resin composition.

In affirming the District Court's decision, this Court said (at Page 27):

> "An additional charge of error is raised by appellant's challenge of the district court's finding that a highway-marking product covered by another patent number was also rendered invalid by the acts prior to the critical date. The patent application of November 12, 1957 concerned a thermoplastic composition which used a styrene resin. That application was abandoned in 1960 and was supplanted by a continuation-in-part application which included different resin ingredients (principally alkyd resin). Appellant urges that the finding of public use and sale in excess of one year prior to patent application should not have been applied to this new patentable alkyd resin product.
>
> "We conclude this argument is untenable. The alkyd resin patent claim is clearly barred by the same public use and sale which barred the styrene resin claim. *The variation represented by the change in resin composition was not demonstrated to have entailed a patentable novelty. The variation involved was but a minor variation of the product,* and added nothing which was patentable. The prior public use or sale which invalidated the patent application of

November 12, 1957 similarly invalidated the continuation-in-part application." (Emphasis added)

In *Greene Process Metal Co. v. Washington Iron Works,* 84 F. 2d 892 (1936), this Court held that:

"All that Greene discovered or claimed to have discovered was that, by changing the proportions of the usual slag constituents, increasing one and decreasing the other, a better result could be accomplished; this result differing only in degree from that of the prior art. Such a discovery is not patentable. (Citing cases)"

* * * * * *

"This case comes clearly within the principle, so often declared, that 'a mere carrying forward of the original thought, a change only in form, proportions, or degree, doing the same thing in the same way, by substantially the same means, with better results, is not such an invention as will sustain a patent.' (Citing cases)"

Recently, this Court cited the *Greene* decision with approval in *Locklin v. Switzer Brothers, Inc.,* 299 F. 2d 160 (1961), and went on to quote *Application of Aller,* 220 F. 2d 454, 456 (C.C.P.A. 1955):

"Normally, it is to be expected that a change in temperature, or in concentration, or in both, would be an unpatentable modification. Under some circumstances, however, changes such as these may impart patentability to a process if the particular ranges claimed produce a new and unexpected result which is different in *kind* and not merely in degree from the results of the prior art. * * * Such ranges are termed 'critical' ranges, and the applicant has the burden of proving such criticality."

* * * * * *

> More particularly, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the *optimum* or workable ranges by routine experimentation." (Emphasis supplied)

The Court of Customs and Patent Appeals in *Application of Rennerfelt,* 265 F. 2d 945 (1959), grounded its holding of unpatentability on this very apposite statement:

> "While the claimed ratios are indicated as *'preferable'* in appellant's application, it is pointed out that the inner roller diameter need merely exceed one-fourth, and the roller thickness be less than one-fifth of the outer diameter. Thus there is no significant difference between the proportions of the reference rollers and those suggested as suitable in appellant's application. The application does not allege, and there is nothing of record to show, that there is any critical difference between the *preferred* proportions which are recited in the claims and those which are merely indicated as suitable." (Emphasis supplied)

There is nothing in the present record or in the patent in suit to show that the limitations of Claims 2 and 4 are critically different from those of Claims 1 and 3; on the contrary, *the specification of the patent in suit* clearly shows the difference to be one of arbitrary preference only. Consequently, on the holding of the *Cataphote* case, *supra,* Claims 2 and 4 must automatically fall together with Claims 1 and 3.

11. SUMMARY JUDGMENT IS APPROPRIATE

The Court below correctly exercised its summary judgment power under Rule 56, F.R.C.P. because there are no disputed issues of fact that could have affected the outcome of the case.

A summary judgment on a defense of public use is historically proper, as was recognized by Judge Yankwich in *Piet v. United States,* 176 F. Supp. 576, 579 (S.D. Calif. 1959):

> ". . . the Court ordered, on June 24, 1959, a separate trial of the defense of invalidity of the patent in suit by reason of public use and sales for more than one year before the filing date of the application.
>
> * * * * * *
>
> "Before us is the determination of the fact whether the defense is made out. If it is, there is no issue to be tried, for, in such circumstances, even a summary judgment would be proper, as the question of validity becomes one of law . . ."

We submit that the decision of the Court below is fully and unalterably supported by the following evidence, all of which was properly before it:

(1) The patent in suit (R. 5-9);

(2) Application Serial No. 67,752 (R. 886-924);

(3) The 1936 Snoek article (R. 683-704);

(4) The 1949 *Electrical Manufacturing* article (R. 271-276); and

(5) The Papian thesis (R. 311-394).

These papers speak for themselves; the Court below understood what they said; and nothing appellant can say can change the written word by one iota.

Appellant cites *Allegheny Ludlum Steel Corp. v. Westinghouse Electric Corp.*, 150 USPQ 95 (D.C.D.C., 1966) as an illustration of a denial of summary judgment in a similar case. Suffice it to say that in that case, Judge Holtzoff felt that the "use of the particular quantities of boron . . . and the reasons for it" went to the question of whether the specified range of boron was an invention patentable over the boron alloy as such, a matter which Judge Holtzoff felt he could not decide without expert testimony.

In the present case, however, it is *assumed* from the outset that the range of S.N. 67,752 and the range of the patent in suit are each patentable inventions in their own right. If it were otherwise, the patent in suit would be invalid over the 1936 Snoek publication. The only question is whether, as a matter of law, the original *disclosure* entitles the *claims* of the patent to the original filing date.

This is a question of law on which expert testimony is not admissible. In *Watson v. Bersworth,* 251 F. 2d 898 (C.A.D.C., 1958), the court held that issues like the one involved here were questions of *law,* not fact, to be decided on the basis of the wording of the applications involved:

> "In 1946 appellees filed an application, Serial No. 657,893, which became Patent No. 2,524,218. If the disclosure in that application would have supported claims like those now in suit, had they been made

then, the doctrine of 'continuity' gives these claims the benefit of the filing date of that application and so entitles them to priority over the references. The Patent Office tribunals ruled that the 1946 disclosure would not have supported claims like these. The District Court held the contrary.

* * * * * *

The difference between the Patent Office and the District Court, and the issue before us, is not factual . . . The appellees do not contend that they are entitled to a patent if their claims are not entitled to priority over those references. The question is not whether an invention has been made. The question is whether the appellees are entitled to claim the invention. The answer turns on the relation between the words of the 1946 application and the words of the 1951 claims. And '*the words of a patent or a patent application, like the words of specific claims therein, always raise a question of law for the court and may not be determined by the opinion of experts.*' (Citing cases.) . . . The 1946 disclosure would or would not have supported claims like the ones now made, according to whether such a general disclosure does or does not, in respect to such specific claims, meet the legal requirement that 'The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such *full, clear, concise* and *exact terms* (emphasis in original) as to enable any person skilled in the art to which it pertains * * * to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.' 35 U.S.C. Sec. 112. '*This is a question of law,* open to this court, precisely as it was open to the court below.' . . .'' (Emphasis added.)

Judge Hall below felt not only perfectly competent but *compelled* to resolve that issue on the basis of the documents in the record (citing Ninth Circuit cases and quoting *Minnesota Mining & Mfg. Co. v. Carborundum Co.*, 155 F. 2d 746, 749 (C.A. 3, 1946), R. 544). Judge Hall worked hard to educate himself in the technical matters involved (Footnote 5, R. 536-537); and even though there be an occasional slip of the pen in technical parts of his opinion, it is evident that he had a thorough understanding of the matter in controversy.

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12. IMPORTANCE OF THE INVENTION

Appellee is not aware of any rule of law which makes the applicability of a statutory bar dependent on the commercial or scientific importance of the invention. An invention is either barred or it isn't, period, and there is no in-between. Consequently, it doesn't matter if appellant's invention is the greatest thing since the wheel, and appellant's comments in that regard (pp. 33-34 of appellant's brief) should be ignored.

CONCLUSION

On the basis of the above considerations, appellee respectfully submits that the decision of the Court below was in all respects correct and should be affirmed.

Dated, January 17, 1968.

Respectfully submitted,
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HARRY G. WEISSENBERGER,
Attorneys for Defendant-Appellee.

CERTIFICATE

I certify that, in connection with the preparation of this brief, I have examined Rules 18, 19, and 39 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

HARRY G. WEISSENBERGER.